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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,926	03/10/2004	Katsuhiko Wakayama	81864.0031	3359
26021	7590	08/22/2006	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			GOFF II, JOHN L	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/797,926

Applicant(s)

WAKAYAMA ET AL.

Examiner

John L. Goff

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/14/04, 10/31/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group II, claims 13-23, in the reply filed on 6/16/06 is acknowledged.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13, 14, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaya et al. (JP 2002359113 and see also the machine translation).

Kaya et al. disclose a production method of a soft magnetic sheet comprising directly or indirectly plating a soft magnetic metal on an insulating resin film to form the soft magnetic sheet and adjusting the magnetic properties of the soft magnetic sheet to form the completed soft magnetic sheet with improved magnetic properties (Paragraphs 13, 14, and 19).

Regarding claim 14, Kaya et al. teach adjusting the magnetic properties is performed by heating the soft magnetic sheet in a stress relaxation heat treatment (Paragraph 19).

Regarding claim 18, Kaya et al. teach laminating a plurality of the soft magnetic sheets (Paragraphs 19 and 21).

Art Unit: 1733

Regarding claim 19, Kaya et al. teach a metal sublayer may be formed on the insulating resin film and then the soft magnetic metal is plated on the metal sublayer (Paragraph 15).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 15-17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaya et al. in view of Ford et al. (U.S. Patent 2,980,561).

Kaya et al. is described above in full detail. Kaya et al. do not teach heat treating of the soft magnetic sheet continuously, heat treating of the soft magnetic sheet under pressure, heat treating of the soft magnetic sheet under tension, or heat treating of the soft magnetic sheet between a pair of rolls at least one of which is maintained at a predetermined temperature.

However, as noted above Kaya et al. teach subjecting the soft magnetic sheet to a stress

Art Unit: 1733

relaxation heat treatment to improve the magnetic properties of the sheet. Ford et al. disclose a production method of a magnetic sheet comprising providing a magnetic metal on an insulating resin to form a magnetic sheet, subjecting the magnetic sheet continuously to a first heat treatment (44 of Figure 1) by passing the magnetic sheet between a pair of indirectly heated rolls (48 and 50 of Figure 1) that apply a predetermined pressure and temperature (i.e. the rolls are maintained at a predetermined temperature) to the magnetic sheet under a tension to improve the flatness of the magnetic sheet and subjecting the magnetic sheet continuously to a second heat treatment (60 of Figure 1) by heating the sheet under tension to improved the magnetic properties of the completed magnetic sheet and remove stress from the completed magnetic sheet (Column 1, lines 15-17 and Column 3, lines 44-75 and Column 4, lines 1-10 and 59-61 and Column 5, lines 14-25 and 51-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the stress relaxation heat treatment as taught by Kaya et al. through a double heat treatment process as shown by Ford et al. to form the completed soft magnetic sheet with improved flatness, magnetic properties, and reduction in stresses.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaya et al. in view of Miyazaki et al. (U.S. Patent 5,674,637).

Kaya et al. is described above in full detail. Kaya et al. do not teach the insulating resin film is formed of polyethylene terephthalate. Kaya et al. teach the insulating resin film is formed of a material having good thermal resistance such as polyimide, polyamide, etc. (Paragraph 13). Miyazaki et al. disclose that in forming a magnetic sheet comprising a magnetic metal on a non-magnetic resin film the resins are usually materials that resist heat such as polyesters, polyamide,

Art Unit: 1733

etc. and in particular polyethylene terephthalate (Column 2, lines 21-25 and Column 3, lines 8-14). Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the insulating resin film taught by Kaya et al. from any of the materials usually used in the art having good heat resistance such as polyamide, polyethylene terephthalate, etc. as shown by Miyazaki et al.

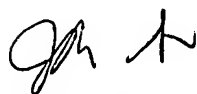
Art Unit: 1733

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John L. Goff